



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,661	09/08/2003	Hiroshi Kashiwagi	KON-1821	2782
20311	7590	08/16/2005	EXAMINER	
MUSERLIAN, LUCAS AND MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016			CHEA, THORL	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 08/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/657,661

Applicant(s)

KASHIWAGI ET AL.

Examiner

Thorl Chea

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 22, 2005 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The definition of S_B and S_A is confusing in view of the specification disclosure. See specification disclosure on page 26 which discloses that "the sensitivity is defined as the reciprocal of an exposure amount giving a minimum density (or a density of the unexposed area) plus 1.0. It is determined using the characteristic curve comprising an abscissa of exposure and an ordinate density. The S_B and S_A cannot be determined by exposing and heating with one exposure and heating step defined in the claimed invention. Applicants is referred to The Theory Of The Photographic Process, Third Edition, T.H. James, page 73, Fig. 4.1 which discloses the characteristic of the curve (density vs. Log E), wherein $E = It$.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1752

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fukui et al (US 2002/0102502).

See Fukui et al column 38, claim 1, 11; pages 23, Example 1, [241] to [0273] to pages 24, 26 ; Table 1, samples 7-9, 14-16 which discloses a photothermographic material containing silver halide, silver salt of an aliphatic carboxylic acid, reducing agent and the compound of formula (1) of the present claimed invention. See also the silver halide grains having grain size of 0.01 to 0.15 micron in [0099], doped with hexacyanometal complex in amount of 10^{-5} to 10^{-2} mole per mole of silver halide including metal complexes of iridium, rhodium and iridium in [0101] to [0112]; the preferable long-chain aliphatic carboxylic acid having grain size of 0.01 to 0.23 in [0086] to [0091]; the preferable silver bromide and silver iodobromide in [0097]. Fukui discloses a photothermographic material having composition as claimed, and therefore, the invention as claimed lacks novelty. The ratio of S_B/S_A fails to differentiate the claimed material with respect to the material of the prior art of record since this sensitivity is determined to the density vs log exposure characteristic which depend on the relative amount of light exposure, rather than the composition of the claimed material. In the case wherein the claims is not

Art Unit: 1752

anticipated by Fukui et al, the claimed material at least would have been found prima facie obvious to the worker of ordinary skill in the art since Fukui et al disclosed the compound of formula (1) claimed in the present claimed invention.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7, 16 of U.S. Patent No. US Patent No. 6,808,872. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of organic silver salt grains encompasses light-insensitive silver salt of an aliphatic carboxylic acid claimed in the present claimed invention.

9. Claims 1-4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Patent Specification 1543266 (PS'266).

See the document as a whole which discloses a photothermographic material containing light insensitive silver salt of an organic acid, a light-sensitive silver halide a reducing agent and a binder; especially the carboxylic group containing silver salts on page 4, lines 19-25, and the compound of formula (I) and (II) and the use of one or more reducing agent on page 15, line 5

Art Unit: 1752

and 34-55; silver halide on pages 6, lines 27-36. PS'266 discloses the compound of formula (II) which is within the scope of formula (I) of the claimed invention. Accordingly, the invention as claimed lacks novelty. Alternatively, it would have been obvious to the worker of ordinary skill in the art to use the compound of formula (I) of PS'266 with an expectation of achieving a similar material. The ratio of S_B/S_A fails to differentiate the claimed material with respect to the material of the prior art of record since this sensitivity is determined to the density vs log exposure characteristic which depends on the relative amount of light exposure, rather than the composition of the claimed material.

10. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1168066 (EP'066) in view of Patent Specification 1543266 (PS'266).

EP'066 discloses a photothermographic material substantially as claimed. See silver halide in column 5, [0026]; the reducing agent on page 27, [0096]; the organic silver salt including the silver salt of a fatty acid on page 4, [0018]; the metal dopant including the transition metal on page 6, [0038] and the chalcogen and nitrogen containing compound on page 28, [0102] and page 33, [0109]. EP'066 fails to disclose the compound of formula (1) claimed in the present claimed invention, but PS'266 discloses that this compound is equivalent to the bisphenol compound disclosed as formula (A) on page 27 of EP'066. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the compound taught in PS'266 in the material of EP'066 in lieu of the compound of formula A with an expectation of achieving at least similar results. The ratio of S_B/S_A fails to differentiate the claimed material with respect to the material of the prior art of record since this sensitivity is determined to the

Art Unit: 1752

density vs log exposure characteristic which depend on the relative amount of light exposure, rather than the composition of the claimed

Response to Arguments

11. Applicant's arguments filed June 17, 2005 have been fully considered but they are not persuasive in view of new ground of rejections above. The Declaration submitted on February 18, 2005 fails to overcome the rejection set forth above. The ratio $S_B/S_A \leq 0.2$ fails to differentiate the composition of the claimed material and that of the prior art. The sensitivity defined in specification is determined by characteristic curve comprising an abscissa of exposure and an ordinate density, and wherein the sensitivity is defined as the reciprocal of an exposure amount giving a minimum density (or a density of the unexposed area) plus 1.0. Therefore, the curve represent the density changing according to the Log Exposure, wherein $\text{Exposure} = It$. This is not necessarily meant that two identical material produce similar density curve or different material would produce different density curve. It is common in photographic art to adjust the exposure to produce a finished material with intended density or contrast. Therefore, the use of the ration of the sensitivity to differentiate the claimed material wherein the composition is identical or similar appears to be not appropriate, and the Declaration has a little weight in the determining the patentability of the claimed invention in view of the applied prior art of record. Moreover, if the claimed material is not anticipated by the material taught in the applied prior art of record, the material as claimed would at least found prima facie obvious to the worker of ordinary skill in the art at the time the invention was made since the additive used in the material have been old in the art such as presented in the rejection above.

Art Unit: 1752

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tchea *tc*
August 13, 2005

Thorl Chea
Thorl Chea
Primary Examiner
Art Unit 1752